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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicant: Jack Beery  
Serial No.: 08/116,019  
Filed: September 2, 1993  
Title: TELEVISION RECEIVER HAVING MEMORY CONTROL FOR  
TUNE-BY-LABEL FEATURE  
Examiner: N. Flynn  
Art Unit: 2602  
Reissue of: U.S. Patent No. 5,045,947  
Issued: September 3, 1991  
Docket No.: JB-2.3

Assistant Commissioner for Patents  
Washington, DC 20231

THIRD SUBSTITUTE DECLARATION (REISSUE)

Dear sir:

I, Jack Beery, hereby declare as follows:

1. My residence and post office address is 1550 Cedar Bark Trail, Unit 1, Dayton, Ohio 45449, and I am a citizen of the United States of America. At the time the above application was filed my residence and post office was 907 Sixth Street, S.W., Suite 815-C, Washington, D.C. 20024.

2. I verily believe I am the original, first and sole inventor of the invention described and claimed in United States Patent No. 5,045,947 issued on September 3, 1991 and entitled TELEVISION RECEIVER HAVING MEMORY CONTROL FOR TUNE-BY-LABEL FEATURE, and described and claimed in the attached specification, for which invention I solicit a reissue patent.

3. I hereby state that I have reviewed and understand the contents of the specification of patent application Serial No. 08/116,019, including the claims as filed and as amended.

4. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §§1.56(a) and 1.175(a)(7).

5. All of the errors set forth below arose without any deceptive intention on my part.

Errors in the Claims

6. I believe the above identified U. S. Patent No. 5,045,947 (hereinafter referred to as the '947 patent) to be partly inoperative or invalid by reason of the Patentee claiming less than he had a right to claim in the '947 patent. The insufficiency in the claims of the '947 patent, the associated errors and the manner in which such errors arose or occurred is specified for each new claim of the reissue application in the paragraphs below:

*Claim 5*

7. A new claim 5 is added in this application to correct the following error: I did not claim in the '947 patent any method of controlling a television receiver, and specifically did not do so in a claim as follows:

A method of controlling a television receiver capable of tuning from a multi-channel input a television channel corresponding to a preassigned channel tuning designation upon receipt of a channel tuning control signal, comprising the steps of:

generating using an operator-actuated control means a first control output signal comprising a first data set representative of at least one desired channel select designation for at least one of said channel tuning designations;

storing in a memory said channel select designation as corresponding to the respective one of said channel tuning designations;

generating using said operator-actuated control means a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

retrieving from said memory the one of said channel tuning designations corresponding to said operator selected channel select designation; and

generating said channel tuning control signal to correspond to said one channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

8. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

9. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I did not realize that my invention could be defined in terms of the method by which the television receiver was controlled. I incorrectly assumed that my invention was embodied in a device. I did not discuss the possibility of presenting a method claim with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a method claim in accord with claim 5 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

10. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and

I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested generally by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented a method claim as a way of protecting my invention, and that I should consider the filing of an application to reissue one or the other of my patents.

11. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

12. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that my invention could be defined in terms of a method claim, although no such claim had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

13. I thereafter asked Mr. Boshinski to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

14. Sometime during July and August of 1993, Mr. Boshinski prepared for my review a claim like that presented as claim 5 in this application. I concluded after reviewing this claim that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent which he was preparing at this time.



15. Claim 5 is unlike any claim of the '947 patent.

*Claim 7*

16. A new claim 7 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

said memory means including means for initially a channel select designation for at least one of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

17. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

18. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary

to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 7 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

19. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

20. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

21. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused

Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

22. I thereafter asked Mr. Boshinski to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

23. Sometime during July and August of 1993, Mr. Boshinski prepared for my review a claim like that presented as claim 7 in this application. I concluded after reviewing this claim that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent which he was preparing at this time.

24. Claim 7 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 7 does not include the tuner means of claim 1, nor is the operator-actuated control means in the form of separate, "first" and "second" means. Claim 7 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 7 include a processor means which includes a "means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...."

#### *Claim 8*

25. A new claim 8 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator. Specifically, I did not claim my invention in a claim which includes:

memory means for storing at least one marker/order bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered cue;

operator actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker/order bit associated with one of said tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said cue;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store any of said marker/order bits associated with one of said channel tuning designations corresponding to the respective place of said channel tuning designation within said cue, and upon receipt of said second data set, reviewing said cue to determine a next in order of said channel tuning designations to have one of said marker/order bits associated therewith, and generating said processor signal to correspond to said next channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

26. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

27. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered cue as determined by the operator. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in an ordered cue could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 8 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

28. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

29. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

30. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in an ordered cue could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

31. I thereafter asked Mr. Boshinski to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

32. Sometime during July and August of 1993, Mr. Boshinski prepared for my review a claim like that presented as claim 8 in this application. I concluded after reviewing this claim that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent which he was preparing at this time.

33. Claim 8 is unlike any claim of the '947 patent as issued.

*Claim 9*

34. A new claim 9 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. Specifically, I did not claim my invention in a claim which includes:

memory means for storing a marker value for at least one of said channel tuning designations, and means for retaining said channel tuning designations in a plurality of ordered cues;

operator actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker value associated with one of said channel tuning designations and one of said cues, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within a selected one of said cues;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store any of said marker values associated with one of said channel tuning designations, and upon receipt of said second data set, reviewing the corresponding one of said cues to determine a next of said channel tuning designations to have one of said marker values associated therewith which corresponds to said cue, and generating said processor signal to correspond to said next channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

35. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

36. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in multiple ordered cues. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in multiple ordered cues could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 9 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

37. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to features of my invention which were independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

38. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

39. In the spring of 1993, I became aware of certain television sets sold by Hitachi Home Electronics (America), Inc. which I believed included a "favorite channel" feature in which channel designations were stored in multiple cues. I thereupon realized that this feature was something which I had invented, and that could be claimed independently of the operator-selected channel designation feature. I discussed this with Mr. Boshinski, who advised me that such claims could have been presented in the application for my '947 patent.

40. I thereafter asked Mr. Boshinski to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

41. Sometime during July and August of 1993, Mr. Boshinski prepared for my review a claim like that presented as claim 9 in this application. I concluded after reviewing this claim that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent which he was preparing at this time.

42. Claim 9 is unlike any claim of the '947 patent as issued.

#### *Claim 10*

43. A new claim 10 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and which includes means for generating a cue selection signal. Specifically, I did not claim my invention in a claim which includes the limitations set forth in claim 9 of this application, and which further includes the limitation that:



said control means further includes means for generating a cue selection signal corresponding to one of said cues, and wherein said processor means, upon receipt of said cue selection signal reviews the one of said cues corresponding thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

44. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

45. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in multiple ordered cues. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. As a result, I did not recognize that I could also claim the means for generating a cue selection signal as a part of such a device. I did not discuss whether the feature relating to selection of cues could be claimed with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 10 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

46. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then

separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me.

47. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

48. In the spring of 1993, I became aware of certain television sets sold by Hitachi Home Electronics (America), Inc. which I believed included a "favorite channel" feature in which channel designations were stored in multiple cues. I thereupon realized that this feature was something which I had invented, and that could be claimed independently of the operator-selected channel designation feature. I discussed this with Mr. Boshinski, who advised me that such claims could have been presented in the application for my '947 patent.

49. Sometime during July and August of 1993, Mr. Boshinski prepared for my review a claim like that presented as claim 9 in this application. While preparing that claim, Mr. Boshinski focused on the multiple cue feature of my invention, and realized that the means for generating a cue selection signal was also a part of my invention, and that a claim to this aspect of the invention could have been presented in the application for the '947 patent but had not. Accordingly, he also prepared claim 10 which he submitted to me for review. I concluded after reviewing this claim that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent which he was preparing at this time.

50. Claim 10 is unlike any claim of the '947 patent as issued.

#### *Claim 11*

51. A new claim 11 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner

means for the television receiver as an element, and specifically did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for storing a marker value for each of said channel select designations, and means for retaining said channel select designations in a plurality of ordered cues;

said control means including means for generating, at the selection of the operator, a part of said first data set representative of the presence of said marker value associated with one of said channel select designations and one of said cues, and means for generating a third data set representative of a command to advance to a subsequent channel select designation within a selected one of said cues;

said processor means, upon receipt of said first data set, causing said memory means to store any of said marker values associated with one of said channel select designations, and upon receipt of said third data set, reviewing the corresponding one of said cues to determine a next of said channel select designations to have one of said marker values associated therewith which corresponds to said cue, and generating said processor signal to correspond to said next channel select designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

52. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

53. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 11 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

54. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

55. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

56. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

57. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

58. In September 1993, a reissue application for the '947 patent was filed.

59. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. At the same time, Mr. Boshinski, Mr. Hokanson and I continued to review my invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, Mr. Boshinski realized that a claim like that presented as claim 11 in this application could have been presented in the application for the '947 patent. Mr. Boshinski discussed his realization with me, and I also concluded that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

60. Claim 11 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 11 does not include the tuner means of claim 1, nor is the operator-actuated control means in the form of separate, "first" and "second" means. Claim 11 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 11 include a processor means which includes a "means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...."

*Claim 12*

61. A new claim 12 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for initially storing a channel select designation for each of said channel tuning designations which is identical thereto; said operator-actuated control means including means for generating a memory clear signal;

said processor means including means for receiving said memory clear signal, and in response thereto, clearing said memory and restoring therein said channel select designation for each of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

62. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

63. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 12 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

64. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful

review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

65. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

66. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

67. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

68. In September 1993, a reissue application for the '947 patent was filed.

69. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. At the same time, Mr. Boshinski, Mr. Hokanson and I continued to review my invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, Mr. Boshinski realized that a claim like that presented as claim 12 in this application could have been presented in the



application for the '947 patent. Mr. Boshinski discussed his realization with me, and I also concluded that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

70. Claim 12 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 12 does not include the tuner means of claim 1, but does include a means by which the memory can be reset to restore the original channel select designations, a feature not found in claim 1.

#### *Claim 13*

71. A new claim 13 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

first operator-actuated control means for generating a first control output signal comprising a first data set representative of a desired channel select designation for one of said channel tuning designations;

second operator-actuated control means distinct and remotely located from said first operator-actuated control means for generating a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said first and second control output signals from said first and second operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations

corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

72. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

73. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 13 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

74. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was

suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

75. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

76. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

77. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

78. In September 1993, a reissue application for the '947 patent was filed.

79. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. At the same time, Mr. Boshinski, Mr. Hokanson and I continued to review my invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, Mr. Boshinski realized that a claim like that presented as claim 13 in this application could have been presented in the application for the '947 patent. Mr. Boshinski discussed his realization with me, and I also

concluded that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

80. Claim 13 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 13 does not include the tuner means of claim 1. However, it does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1.

#### *Claim 14*

81. A new claim 14 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

first operator-actuated control means for generating a first control output signal comprising a first data set representative of a desired channel select designation for one of said channel tuning designations;

means for receiving said first data set and causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation;

second operator-actuated control means distinct and remotely located from said first operator-actuated control means for generating a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said second control output signal from said second operator-actuated control means, and upon receipt thereof, retrieving from said memory

means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

82. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

83. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 14 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

84. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful

review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

85. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

86. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

87. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

88. In September 1993, a reissue application for the '947 patent was filed.

89. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. At the same time, Mr. Boshinski, Mr. Hokanson and I continued to review my invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, Mr. Boshinski realized that a claim like that presented as claim 14 in this application could have been presented in the

application for the '947 patent. Mr. Boshinski discussed his realization with me, and I also concluded that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

90. Claim 14 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 14 does not include the tuner means of claim 1. However, it does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1.

*Claim 15*

91. A new claim 15 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for storing more than one of said channel select designations corresponding to a single one of said channel tuning designations.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

92. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

93. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 15 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

94. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was



suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

95. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

96. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

97. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

98. In September 1993, a reissue application for the '947 patent was filed.

99. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. At the same time, Mr. Boshinski, Mr. Hokanson and I continued to review my invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, Mr. Boshinski realized that a claim like that presented as claim 15 in this application could have been presented in the application for the '947 patent. Mr. Boshinski discussed his realization with me, and I also

concluded that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

100. Claim 15 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an one operator-actuated control means and a processor means substantially as set out above. Claim 15 does not include the tuner means of claim 1. However, it does require that the memory means be capable of storing more than one channel select designation for at least one tuning designation, which is not found in claim 1.

*Claim 16*

101. A new claim 16 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. Specifically, I did not claim my invention in a claim which includes:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing at least one marker/order bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered cue;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker/order bit associated with one of said channel tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said cue;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store any of said marker/order bits associated with one of said channel tuning designations corresponding to the respective place of said channel tuning designation within said cue, and upon receipt of said second data set, reviewing said cue to determine a next in order of said channel tuning designations to have one of said marker/order bits

associated therewith, and generating said processor signal to correspond to said next channel tuning designation;

said memory means including means for storing at least one order bit for each of said channel tuning designations which have one of said marker bits associated therewith which comprises said means for retaining said channel tuning designations in said ordered cue;

said processor means, upon receipt of said first data set, causing said memory means to store an order bit associated with said channel tuning designation which has one of said marker bits associated therewith corresponding to the respective place of said channel tuning designation within said cue, and upon receipt of said third data signal, determining said next of said channel tuning designations which have one of said marker bits associated therewith by reviewing said order bits.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

102. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

103. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered cue. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in an ordered cue could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 16 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

104. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller

of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

105. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

106. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

107. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

108. In September 1993, a reissue application for the '947 patent was filed.

109. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. At the same time, Mr. Boshinski, Mr. Hokanson and I continued to review my invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, Mr. Boshinski realized that a claim like that presented as claim 16 in this application could have been presented in the application for the '947 patent. Mr. Boshinski discussed his realization with me, and I also concluded that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

110. Claim 16 is unlike any claim of the '947 patent as issued.

*Claim 17*

111. A new claim 17 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store

said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

said memory means including means for initially storing a channel select designation for at least one of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

112. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

113. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 17 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

114. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then

separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

115. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

116. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

117. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

118. In September 1993, a reissue application for the '947 patent was filed.

119. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

120. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

121. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 17 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

122. Claim 17 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 17 does not include the tuner means of claim 1, nor is the operator-actuated control means in the form of separate, "first" and "second" means. Claim 17 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 17 include a processor means which includes a "means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...."



*Claim 18*

123. A new claim 18 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store, for each of the channel tuning designations, a channel select designation which was identical thereto. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not claim my invention in a claim which includes the limitations set forth in claim 17 of this application, and which further includes the limitation that:

said memory means includes means for storing, for a plurality of said channel tuning designations, a channel select designation for each of said plurality of channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

124. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

125. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could claim an apparatus which could not only store channel select designations identical to some of the channel tuning designations, but also in which identical channel select designations were stored for all channel tuning designations.

126. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is

limited in this regard). I did not discuss whether the language "in response to" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

127. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 18 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

128. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims in one or the other of these applications see, e.g., the discussion of claim 5, *supra*), and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

129. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

130. In September 1993, a reissue application for the '947 patent was filed.

131. The specific error corrected by claim 18 was discovered sometime during the period from March through August, 1994. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of." As a result of their review, Mr. Boshinski realized that a claim like that presented as claim 18 in this application could have been presented in the application for the '947 patent. Mr. Boshinski discussed his realization with me, and I concluded that such a claim that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

132. Claim 18 is unlike any claim of the '947 patent as issued.

#### *Claim 19*

133. A new claim 19 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus receives a multi-channel input including a plurality of active channels, and in which the memory stores a channel select designation for each of the active channels which is identical thereto.

Specifically, I did not claim my invention in a claim which includes the limitations set forth in claim 18 of this application, and which further includes the limitation that:

said multi-channel input includes a plurality of active channels, said memory means including means for storing a channel select designation for each of said active channels which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

134. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

135. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could claim an apparatus which could not only store channel select designations identical to some of the channel tuning designations, but also in which identical channel select designations were stored for all channel tuning designations corresponding to active channels from the multi-channel input. I did not discuss whether this aspect of the device could be claimed with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

136. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response to" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

137. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 19 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

138. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims in one or the other of these applications (see, e.g., the discussion of claim 5, *supra*), and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

139. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

140. In September 1993, a reissue application for the '947 patent was filed.

141. The specific error corrected by claim 19 was discovered sometime during the period from March through August, 1994. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to

the Office action. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of." As a result of their review, Mr. Boshinski realized that a claim like that presented as claim 19 in this application could have been presented in the application for the '947 patent. Mr. Boshinski discussed his realization with me, and I concluded that such a claim that such a claim was, through error, not presented in the original application for the '947 patent. I then asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

142. Claim 19 is unlike any claim of the '947 patent as issued.

#### *Claim 21*

143. A new claim 21 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not claim my invention in a claim which includes:

memory means for storing at least one marker/order bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered cue;

operator actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker/order bit associated with one of said tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said cue;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store any of said marker/order bits associated with one of said channel tuning designations corresponding to the respective place of said channel tuning designation within said cue, and in response to said second data set, reviewing said cue to determine a next in order of said channel tuning designations to have one of said marker/order bits associated therewith, and generating said processor signal to correspond to said next channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

144. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

145. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered cue as determined by the operator. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in an ordered cue could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

146. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response to" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

147. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 21 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

148. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.



149. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

150. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in an ordered cue could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

151. In September 1993, a reissue application for the '947 patent was filed.

152. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

153. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

154. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 21 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

155. Claim 21 is unlike any claim of the '947 patent as issued.

*Claim 22*

156. A new claim 22 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not claim my invention in a claim which includes:

memory means for storing a marker value for at least one of said channel tuning designations, and means for retaining said channel tuning designations in a plurality of ordered cues;

operator actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker value associated with one of said channel tuning designations and one of said cues, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within a selected one of said cues;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store any of said marker values associated with one of said channel tuning designations, and in response to said second data set, reviewing the corresponding one of said cues to determine a next of said channel tuning designations to have one of said marker values associated therewith which corresponds to said cue, and generating said processor signal to correspond to said next channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

157. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

158. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in multiple ordered cues. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in multiple ordered cues could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

159. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response to" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

160. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 22 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

161. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in multiple ordered cues independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

162. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

163. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

164. In September 1993, a reissue application for the '947 patent was filed.

165. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

166. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

167. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 22 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

168. Claim 22 is unlike any claim of the '947 patent as issued.

#### *Claim 23*

169. A new claim 23 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a

control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for storing a marker value for each of said channel select designations, and means for retaining said channel select designations in a plurality of ordered cues;

said control means including means for generating, at the selection of the operator, a part of said first data set representative of the presence of said marker value associated with one of said channel select designations and one of said cues, and means for generating a third data set representative of a command to advance to a subsequent channel select designation within a selected one of said cues;

said processor means, in response to said first data set, causing said memory means to store any of said marker values associated with one of said channel select designations, and in response to said third data set, reviewing the corresponding one of said cues to determine a next of said channel select designations to have one of said marker values associated therewith which corresponds to said cue, and generating said processor signal to correspond to said next channel select designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

170. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

171. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

172. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response to" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

173. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 23 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

174. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the

possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

175. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

176. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

177. In September 1993, a reissue application for the '947 patent was filed.

178. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.



179. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

180. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 23 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

181. Claim 23 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 23 does not include the tuner means of claim 1, nor is the operator-actuated control means in the form of separate, "first" and "second" means. Claim 11 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 23 include a processor means which includes a "means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...." Further, in claim 23 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal.

*Claim 24*

182. A new claim 24 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for initially storing a channel select designation for each of said channel tuning designations which is identical thereto; said operator-actuated control means including means for generating a memory clear signal;

said processor means including means for receiving said memory clear signal, and in response thereto, clearing said memory and restoring therein said channel select designation for each of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

183. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

184. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

185. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response to" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

186. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 24 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

187. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the

possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

188. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

189. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

190. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

191. In September 1993, a reissue application for the '947 patent was filed.

192. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

193. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

194. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 24 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

195. Claim 24 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 24 does not include the tuner means of claim 1, but does include a means by which the memory can be reset to restore the original channel select designations, a feature not found in claim 1. Further, in claim 24 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal.

*Claim 25*

196. A new claim 25 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

first operator-actuated control means for generating a first control output signal comprising a first data set representative of a desired channel select designation for one of said channel tuning designations;

second operator-actuated control means distinct and remotely located from said first operator-actuated control means for generating a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said first and second control output signals from said first and second operator-actuated control means, and in response to said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

197. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

198. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

199. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response to" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

200. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 25 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

201. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then

separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

202. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

203. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

204. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

205. In September 1993, a reissue application for the '947 patent was filed.

206. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.



207. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

208. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 25 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

209. Claim 25 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 25 does not include the tuner means of claim 1. However, it does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1. Further, in claim 25 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal.

*Claim 26*

210. A new claim 26 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

first operator-actuated control means for generating a first control output signal comprising a first data set representative of a desired channel select designation for one of said channel tuning designations;

means for receiving said first data set and causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation;

second operator-actuated control means distinct and remotely located from said first operator-actuated control means for generating a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said second control output signal from said second operator-actuated control means, and in response thereto, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

211. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

212. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

213. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

214. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 26 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

215. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then

separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

216. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

217. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

218. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

219. In September 1993, a reissue application for the '947 patent was filed.

220. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

221. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

222. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 26 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

223. Claim 26 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 26 does not include the tuner means of claim 1. However, it does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1. Further, in claim 26 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal.

*Claim 27*

224. A new claim 27 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for storing more than one of said channel select designations corresponding to a single one of said channel tuning designations.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

225. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

226. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary

to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

227. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

228. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 27 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

229. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful

review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

230. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

231. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

232. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

233. In September 1993, a reissue application for the '947 patent was filed.

234. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

235. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon



receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

236. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 27 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

237. Claim 27 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an one operator-actuated control means and a processor means substantially as set out above. Claim 27 does not include the tuner means of claim 1. However, it does require that the memory means be capable of storing more than one channel select designation for at least one tuning designation, which is not found in claim 1. Further, in claim 27 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal.

#### *Claim 28*

238. A new claim 28 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the

presence of a particular signal. Specifically, I did not claim my invention in a claim which includes:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing at least one marker bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered cue;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker bit associated with one of said channel tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said cue;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store any of said marker bits associated with one of said channel select designations corresponding to the respective place of said channel select designation within said cue, and in response to said second data set, reviewing said cue to determine a next in order of said channel tuning designations to have one of said marker bits associated therewith, and generating said processor signal to correspond to said next channel tuning designation;

said memory means including means for storing at least one order bit for each of said channel tuning designations which have one of said marker bits associated therewith which comprises said means for retaining said channel tuning designations in said ordered cue;

said processor means, in response to said first data set, causing said memory means to store an order bit associated with said channel tuning designation which has one of said marker bits associated therewith corresponding to the respective place of said channel tuning designation within said cue, and in response to said third data signal, determining said next of said channel tuning designations which have one of said marker bits associated therewith by reviewing said order bits.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

239. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

240. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered cue. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in an ordered cue could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

241. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

242. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 28 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

243. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January

through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

244. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

245. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

246. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

247. In September 1993, a reissue application for the '947 patent was filed.

248. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

249. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

250. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 28 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

251. Claim 28 is unlike any claim of the '947 patent as issued.

#### *Claim 30*

252. A new claim 30 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a

control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not do so in a claim which included the following elements:

a memory adapted to store at least one operator-assigned channel select designation for at least one of said channel tuning designations;

an operator-actuated control device for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

a processor that receives said control output signal from said operator-actuated control device, and in response to said first data set, causes said memory to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieves from said memory the one of said channel tuning designations corresponding to said operator selected channel select designation, and generates said channel tuning control signal to correspond to said one channel tuning designation;

said memory further being adapted to initially store a channel select designation for at least one of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

253. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

254. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner was a

necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

255. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as "means" for performing various functions, and it did not occur to him or me that language which recited elements in a form other than as a "means" for performing a function could also have been used.

256. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 30 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

257. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuner as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

258. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

259. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuner was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

260. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

261. In September 1993, a reissue application for the '947 patent was filed.

262. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

263. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.



264. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 30 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

265. Claim 30 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory/memory means, an operator-actuated control device/operator-actuated control means and a processor/processor means substantially as set out above. Claim 30 does not include the tuner means of claim 1, nor is the operator-actuated control device in the form of separate, "first" and "second" devices. Claim 30 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 30 include a processor which includes a "means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...." Unlike claim 1, claim 30 does not express the various claim elements in terms of "means."

#### *Claim 31*

266. A new claim 31 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator. I further did not claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not do so in a claim which includes:

a tuner for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

a memory adapted to store at least one marker/order bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered cue;

an operator-actuated control device for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker/order bit associated with one of said channel tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said cue;

a processor that receives said control output signal from said operator-actuated control device, and in response to said first data set, causes said memory means to store any of said marker/order bits associated with one of said channel tuning designations corresponding to the respective place of said channel tuning designation within said cue, and in response to said second data set, reviews said cue to determine a next in order of said channel tuning designations to have one of said marker/order bits associated therewith, and generates said processor signal to correspond to said next channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

267. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

268. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered cue as determined by the operator. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in an ordered cue could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

269. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as "means" for performing various functions, and it did not occur to him or me that language which

recited elements in a form other than as a "means" for performing a function could also have been used.

270. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 31 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

271. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

272. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

273. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947

patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in an ordered cue could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

274. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

275. In September 1993, a reissue application for the '947 patent was filed.

276. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

277. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.

278. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 31 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

279. Claim 31 is unlike any claim of the '947 patent as issued.

*Claim 32*

280. A new claim 32 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. I further did not claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not claim my invention in a claim which includes:

a tuner for receiving said multi-channel input signal and tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

a memory adapted to store a marker value for at least one of said channel tuning designations, and for retaining said channel tuning designations in a plurality of ordered cues;

an operator-actuated control device for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker value associated with one of said channel tuning designations and one of said cues, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within a selected one of said cues;

a processor that receives said control output signal from said operator-actuated control device, and upon receipt of said first data set, causes said memory to store any of said marker values associated with one of said channel tuning designations, and upon receipt of said second data set, reviews the corresponding one of said cues to determine a next of said channel tuning designations to have one of said marker values associated therewith which corresponds to said cue, and generating said processor signal to correspond to said next channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

281. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

282. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in multiple ordered cues. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in multiple ordered cues could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

283. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as "means" for performing various functions, and it did not occur to him or me that language which recited elements in a form other than as a "means" for performing a function could also have been used.

284. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 32 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

285. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the

merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in multiple ordered cues independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

286. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

287. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

288. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

289. In September 1993, a reissue application for the '947 patent was filed.

290. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

291. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.

292. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 32 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

293. Claim 32 is unlike any claim of the '947 patent as issued.

*Claim 33*

294. A new claim 33 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not claim my invention in a claim which includes:

a memory adapted to store at least one operator-assigned channel select designation for at least one of said channel tuning designations;

an operator-actuated control device for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said



channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

a processor that receives said control output signal from said operator-actuated control device, and in response to said first data set, causes said memory to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieves from said memory the one of said channel tuning designations corresponding to said operator selected channel select designation, and generates said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory further stores a marker value for each of said channel select designations, and retains said channel select designations in a plurality of ordered cues;

said control device further generating, at the selection of the operator, a part of said first data set representative of the presence of said marker value associated with one of said channel select designations and one of said cues, and generating a third data set representative of a command to advance to a subsequent channel select designation within a selected one of said cues;

said processor, in response to said first data set, causes said memory to store any of said marker values associated with one of said channel select designations, and in response to said third data set, reviews the corresponding one of said cues to determine a next of said channel select designations to have one of said marker values associated therewith which corresponds to said cue, and generates said processor signal to correspond to said next channel select designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

295. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

296. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the

tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

297. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as "means" for performing various functions, and it did not occur to him or me that language which recited elements in a form other than as a "means" for performing a function could also have been used.

298. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 33 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

299. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

300. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

301. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

302. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

303. In September 1993, a reissue application for the '947 patent was filed.

304. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

305. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.

306. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 33 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

307. Claim 33 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory/memory means, an operator-actuated control device/operator-actuated control means and a processor/processor means substantially as set out above. Claim 33 does not include the tuner means of claim 1, nor is the operator-actuated control device in the form of separate, "first" and "second" means. Claim 33 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 11 include a processor means which includes a "means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...." Unlike claim 1, claim 33 does not express the various claim elements in terms of "means."

#### *Claim 34*

308. A new claim 34 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner for the television receiver as an element. I further did not claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not claim my invention in a claim which includes:

a memory adapted to store at least one operator-assigned channel select designation for at least one of said channel tuning designations;

an operator-actuated control device for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

a processor that receives said control output signal from said operator-actuated control device, and in response to said first data set, causes said memory to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieves from said memory the one of said channel tuning designations corresponding to said operator selected channel select designation, and generates said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory is adapted to initially store a channel select designation for each of said channel tuning designations which is identical thereto;

said operator-actuated control device being adapted to generate a memory clear signal;

wherein said processor receives said memory clear signal, and in response thereto, clears said memory and restores therein said channel select designation for each of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

309. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

310. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

311. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as

"means" for performing various functions, and it did not occur to him or me that language which recited elements in a form other than as a "means" for performing a function could also have been used.

312. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 34 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

313. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

314. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

315. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused

Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

316. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

317. In September 1993, a reissue application for the '947 patent was filed.

318. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

319. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.

320. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 34 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

321. Claim 34 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory/memory means, an operator-actuated control device/operator-actuated control means and a processor/processor means substantially as set out above. Claim 34 does not include the tuner means of claim 1, but does include a processor by which the memory can be reset to restore the original channel select designations, a feature not found in claim 1. Unlike claim 1, claim 34 does not express the various claim elements in terms of "means."

*Claim 35*

322. A new claim 35 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not claim my invention in a claim which includes:

a memory adapted to store at least one operator-assigned channel select designation for at least one of said channel tuning designations;

a first operator-actuated control device for generating a first control output signal comprising a first data set representative of a desired channel select designation for one of said channel tuning designations;

a second operator-actuated control device distinct and remotely located from said first operator-actuated control device for generating a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

a processor that receives said first and second control output signals from said first and second operator-actuated control devices, and in response to said first data set, causes said memory to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieves from said memory the one of said channel tuning designations corresponding to said operator selected channel select designation, and generates said channel tuning control signal to correspond to said one channel tuning designation.



I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

323. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

324. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

325. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as "means" for performing various functions, and it did not occur to him or me that language which recited elements in a form other than as a "means" for performing a function could also have been used.

326. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 35 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

327. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the

possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

328. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

329. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

330. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

331. In September 1993, a reissue application for the '947 patent was filed.

332. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

333. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.

334. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 35 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

335. Claim 35 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory/memory means, at least one operator-actuated control device/operator-actuated control means and a processor/processor means substantially as set out above. Claim 35 does not include the tuner means of claim 1. However, it does require both first and second operator-actuated control devices, one for generating the first data set and the other for generating the second data set, which is not found in claim 1. Unlike claim 1, claim 35 does not express the various claim elements in terms of "means."

*Claim 36*

336. A new claim 15 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not claim my invention in a claim which includes:

a memory adapted to store at least one operator-assigned channel select designation for at least one of said channel tuning designations;

an operator-actuated control device for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

a processor that receives said control output signal from said operator-actuated control device, and in response to said first data set, causes said memory to store said desired channel select designation as corresponding to said one channel tuning designation, and in response to said second data set, retrieves from said memory the one of said channel tuning designations corresponding to said operator selected channel select designation, and generates said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory is adapted to store more than one of said channel select designations corresponding to a single one of said channel tuning designations.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

337. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

338. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary

to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

339. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as "means" for performing various functions, and it did not occur to him or me that language which recited elements in a form other than as a "means" for performing a function could also have been used.

340. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 36 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

341. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have

presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

342. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

343. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

344. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

345. In September 1993, a reissue application for the '947 patent was filed.

346. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

347. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that

broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.

348. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 36 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

349. Claim 36 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory/memory means, an operator-actuated control device/operator-actuated control means and a processor/processor means substantially as set out above. Claim 36 does not include the tuner means of claim 1. However, it does require that the memory be capable of storing more than one channel select designation for at least one tuning designation, which is not found in claim 1.

#### *Claim 37*

350. A new claim 37 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. I further did not claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." Specifically, I did not claim my invention in a claim which includes:

a tuner for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

a memory adapted to store at least one marker/order bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered cue;

an operator-actuated control device for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker/order bit associated with one of said channel tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said cue;

a processor that receives said control output signal from said operator-actuated control device, and in response to said first data set, causes said memory to store any of said marker/order bits associated with one of said channel tuning designations corresponding to the respective place of said channel tuning designation within said cue, and in response to said second data set, reviews said cue to determine a next in order of said channel tuning designations to have one of said marker/order bits associated therewith, and generates said processor signal to correspond to said next channel tuning designation;

said memory being adapted to store at least one order bit for each of said channel tuning designations which have one of said marker/order bits associated therewith which retains said channel tuning designations in said ordered cue;

wherein said processor, in response to said first data set, causes said memory to store an order bit associated with said channel tuning designation which has one of said marker/order bits associated therewith corresponding to the respective place of said channel tuning designation within said cue, and in response to said third data signal, determines said next of said channel tuning designations which have one of said marker/order bits associated therewith by reviewing said order bits.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

351. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

352. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered cue. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel



designations in an ordered cue could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

353. I also erroneously did not claim my invention using as elements of the device a "tuner," a "memory," an "operator-actuated control device," and a "processor." This was because Mr. Boshinski, in preparing the claims of the '947 application, identified the claim elements as "means" for performing various functions, and it did not occur to him or me that language which recited elements in a form other than as a "means" for performing a function could also have been used.

354. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 37 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

355. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

356. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

357. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

358. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

359. In September 1993, a reissue application for the '947 patent was filed.

360. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

361. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that a court decision had been issued that caused him to consider whether the application for the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions. I understand from Mr. Boshinski that this decision is *In re Donaldson* (29 USPQ2d 1845). Mr. Boshinski explained to me that broader claims could result from avoidance of these kind of limitations, and suggested that claims which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent, although such claims could have been.

362. After discussing this with Mr. Boshinski, and his realization that a claim specifically like that presented as claim 37 in this application could have been presented in the original application for the '947 patent, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

363. Claim 37 is unlike any claim of the '947 patent as issued.

*Claim 38*

364. A new claim 38 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which a memory clear signal can be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto. Specifically, I did not do so in a claim which included the following elements:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing at least one operator-assigned channel select designation for each of a plurality of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said processor signal to correspond to said one channel tuning designation;

wherein said memory means includes means for initially storing a channel select designation for each of said plurality of said channel tuning designations which is identical thereto;

said operator-actuated control means including means for generating a memory clear signal;

said processor means including means for receiving said memory clear signal, and in response thereto, clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

365. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

366. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could have claimed an apparatus in which a memory clear signal could be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto. This was because I concentrated too narrowly on the preferred embodiment for my device, in which it was constructed so that the memory clear signal restored all select designations to ones identical to their corresponding channel tuning designations. I did not discuss whether I could claim the apparatus more broadly with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 38 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

367. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January

through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

368. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

369. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

370. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

371. In September 1993, a reissue application for the '947 patent was filed.

372. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

373. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that based upon his consideration of the present application and his discussions with Mr. Hokanson, the application for the '947 patent could have supported a claim to a device that included "means for storing at least one operator-assigned channel select designation for each of a plurality of said channel tuning designations," and wherein the processor means is for clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto." I understood from Mr. Boshinski that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been.

374. After discussing this with Mr. Boshinski, I asked him to include a claim such as claim 38 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

375. Claim 38 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 38 includes a means by which the memory can be reset to restore the original channel select designations, a feature not found in claim 1.

#### *Claim 39*

376. A new claim 39 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which a memory clear signal can be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto. Further, I did not claim in the '947 patent a control

apparatus for a television receiver that did not include a tuner means for the television receiver as an element. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned channel select designation for each of a plurality of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for initially storing a channel select designation for each of said plurality of said channel tuning designations which is identical thereto;

said operator-actuated control means including means for generating a memory clear signal;

said processor means including means for receiving said memory clear signal, and in response thereto, clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

377. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

378. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could have claimed an apparatus in which a memory clear signal could be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto. This was because I concentrated too narrowly on the preferred embodiment for my device, in which it was constructed so that the memory clear signal restored all select designations to ones identical to their corresponding channel tuning designations. I did not discuss whether I could claim the apparatus more broadly with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

379. Also during the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

380. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 39 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

381. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then



separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

382. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

383. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

384. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

385. In September 1993, a reissue application for the '947 patent was filed.

386. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

387. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that based upon his consideration of the present application and his discussions with Mr. Hokanson, the application for the '947 patent could have supported a claim to a device that included "means for storing at least one operator-assigned channel select designation for each of a plurality of said channel tuning designations," and wherein the processor means is for clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto." I understood from Mr. Boshinski that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been.

388. After discussing this with Mr. Boshinski, I asked him to include a claim such as claim 39 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

389. Claim 39 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 39 includes a means by which the memory can be reset to restore the original channel select designations, a feature not found in claim 1. Claim 39 does not include the tuner means as a claim element, as is found in claim 1.

*Claim 40*

390. A new claim 40 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences. Specifically, I did not claim my invention in a claim which includes:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing a marker value for at least one of said channel tuning designations, and means for retaining said channel tuning designations in a plurality of scroll sequences;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker value associated with one of said channel tuning designations and one of said scroll sequences, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within a selected one of said scroll sequences;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store any of said marker values associated with one of said channel tuning designations, and upon receipt of said second data set, reviewing the corresponding one of said scroll sequences to determine a next of said channel tuning designations to have one of said marker values associated therewith which corresponds to said scroll sequence, and generating said processor signal to correspond to said next channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

391. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

392. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in multiple ordered scroll sequences. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in multiple ordered scroll sequences could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

393. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 40 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

394. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in multiple ordered cues independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

395. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

396. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such

claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

397. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

398. In September 1993, a reissue application for the '947 patent was filed.

399. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

400. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that based upon his consideration of the present application and his discussions with Mr. Hokanson concerning the litigation, the application for the '947 patent could have supported a claim to a device that defined the invention using the term "scroll sequence" rather than the term "cue," and that such a claim could be interpreted differently than a claim which used the term "cue." I understood from Mr. Boshinski that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been.

401. After discussing this with Mr. Boshinski, I asked him to include a claim such as claim 40 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

402. Claim 40 is unlike any claim of the '947 patent as issued.

*Claim 41*

403. A new claim 41 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and which includes means for generating a scroll sequence selection signal. Specifically, I did not claim my invention in a claim which includes the limitations set forth in claim 40 of this application, and which further includes the limitation that:

means for generating a scroll sequence selection signal corresponding to one of said scroll sequences, and wherein said processor means, upon receipt of said scroll sequence selection signal reviews the one of said scroll sequences corresponding thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

404. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

405. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in multiple ordered scroll sequences. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. As a result, I did not recognize that I could also claim the means for generating a scroll sequence selection signal as a part of such a device. I did not discuss whether the feature relating to selection of scroll sequences could be claimed with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 41 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

406. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me.

407. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

408. In the spring of 1993, I became aware of certain television sets sold by Hitachi Home Electronics (America), Inc. which I believed included a "favorite channel" feature in which channel designations were stored in multiple cues. I thereupon realized that this feature was something which I had invented, and that could be claimed independently of the operator-selected channel designation feature. I discussed this with Mr. Boshinski, who advised me that such claims could have been presented in the application for my '947 patent.

409. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

410. In September 1993, a reissue application for the '947 patent was filed.

411. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

412. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that based upon his consideration of the present application and his discussions with Mr. Hokanson concerning the litigation, the application for the '947 patent could have supported a claim to a device that defined the invention using the term "scroll sequence" rather than the term "cue," and that such language could be interpreted differently than a claim which used the term "cue." Mr. Boshinski further advised me that he had recognized that the means for generating a scroll sequence selection signal was also a part of my invention, and that a claim to this aspect of the invention could have been presented in the application for the '947 patent but had not.

413. After discussing this with Mr. Boshinski, I asked him to include a claim such as claim 41 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

414. Claim 41 is unlike any claim of the '947 patent as issued.

*Claim 42*

415. A new claim 42 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of scroll sequences. Specifically, I did not claim my invention in a claim which includes:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing at least one marker/order bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered scroll sequence;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker/order bit associated with



one of said channel tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said scroll sequence;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store any of said marker/order bits associated with one of said channel tuning designations corresponding to the respective place of said channel tuning designation within said scroll sequence, and upon receipt of said second data set, reviewing said scroll sequence to determine a next in order of said channel tuning designations to have one of said marker/order bits associated therewith, and generating said processor signal to correspond to said next channel tuning designation;

said memory means including means for storing at least one order bit for each of said channel tuning designations which have one of said marker bits associated therewith which comprises said means for retaining said channel tuning designations in said ordered scroll sequence;

said processor means, upon receipt of said first data set, causing said memory means to store an order bit associated with said channel tuning designation which has one of said marker bits associated therewith corresponding to the respective place of said channel tuning designation which has one of said marker bits associated therewith within said scroll sequence, and upon receipt of said third data signal, determining said next of said channel tuning designations which have one of said marker bits associated therewith by reviewing said order bits.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

416. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

417. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered scroll sequence. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected

channel designation feature. I did not discuss whether the feature relating to storage of channel designations in an ordered scroll sequence could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 42 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

418. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

419. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

420. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel

designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

421. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

422. In September 1993, a reissue application for the '947 patent was filed.

423. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

424. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that based upon his consideration of the present application and his discussions with Mr. Hokanson concerning the litigation, the application for the '947 patent could have supported a claim to a device that defined the invention using the term "scroll sequence" rather than the term "cue," and that such a claim could be interpreted differently than a claim which used the term "cue." I understood from Mr. Boshinski that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been.

425. After discussing this with Mr. Boshinski, I asked him to include a claim such as claim 42 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

426. Claim 42 is unlike any claim of the '947 patent as issued.

*Claim 43*

427. A new claim 43 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not claim my invention in a claim which includes:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing at least one marker/order bit for at least one of said channel tuning designations, for retaining said channel tuning designations in an ordered scroll sequence;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of the presence of said marker/order bit associated with one of said channel tuning designations, and (b) a second data set representative of a command to advance to a subsequent channel tuning designation within said scroll sequence;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store any of said marker/order bits associated with one of said channel tuning designations corresponding to the respective place of said channel tuning designation within said scroll sequence, and in response to said second data set, reviewing said scroll sequence to determine a next in order of said channel tuning designations to have one of said marker/order bits associated therewith, and generating said processor signal to correspond to said next channel tuning designation;

said memory means including means for storing at least one order bit for each of said channel tuning designations which have one of said marker bits associated therewith which comprises said means for retaining said channel tuning designations in said ordered scroll sequence;

said processor means, in response to said first data set, causing said memory means to store an order bit associated with said channel tuning designation which has one of said marker bits associated therewith corresponding to the respective place of said channel

tuning designation within said scroll sequence, and in response to said third data signal, determining said next of said channel tuning designations which have one of said marker bits associated therewith by reviewing said order bits.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

428. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

429. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in an ordered scroll sequence. This was because in the preferred embodiment for my device, I expected it to be constructed such a feature to be incorporated into a remote control device in combination with the operator-selected channel designation feature. I did not discuss whether the feature relating to storage of channel designations in an ordered scroll sequence could be claimed independently with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

430. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

431. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 43 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

432. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

433. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

434. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such

claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

435. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

436. In September 1993, a reissue application for the '947 patent was filed.

437. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

438. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

439. During this same time, Mr. Boshinski advised me that based upon his consideration of the present application and his discussions with Mr. Hokanson concerning the litigation, the application for the '947 patent could have supported a claim to a device that defined the invention using the term "scroll sequence" rather than the term "cue," and that such a claim

could be interpreted differently than a claim which used the term "cue." I understood from Mr. Boshinski that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been.

440. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 43 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

441. Claim 43 is unlike any claim of the '947 patent as issued.

*Claim 44*

442. A new claim 44 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences. Specifically, I did not claim my invention in a claim which includes:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means



the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said processor signal to correspond to said one channel tuning designation;

wherein said memory means includes means for storing a marker value for each of said channel select designations, and means for retaining said channel select designations in a plurality of scroll sequences;

said control means including means for generating, at the selection of the operator, a part of said first data set representative of the presence of said marker value associated with one of said channel select designations and one of said scroll sequences, and means for generating a third data set representative of a command to advance to a subsequent channel select designation within a selected one of said scroll sequences;

said processor means, upon receipt of said first data set, causing said memory means to store any of said marker values associated with one of said channel select designations, and upon receipt of said third data set, reviewing the corresponding one of said scroll sequences to determine a next of said channel select designations to have one of said marker values associated therewith which corresponds to said scroll sequences, and generating said processor signal to correspond to said next channel select designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

443. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

444. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could independently claim an apparatus which could store channel designations in multiple ordered scroll sequences. This was because in preparing my applications for both my '734 and '947 patents, I considered the ordered channel select designations to be stored in one or more ordered "cues." It did not occur to me that such an order could also be claimed using the language "scroll sequence." I did not discuss this claim language with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

445. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 44 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

446. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims relating to my invention, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

447. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

448. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

449. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

450. In September 1993, a reissue application for the '947 patent was filed.

451. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

452. During this time in which a response to the Office action was being prepared, Mr. Boshinski advised me that based upon his consideration of the present application and his discussions with Mr. Hokanson concerning the litigation, the application for the '947 patent could have supported a claim to a device that defined the invention using the term "scroll sequence" rather than the term "cue," and that such a claim could be interpreted differently than a claim which used the term "cue." I understood from Mr. Boshinski that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been.

453. After discussing this with Mr. Boshinski, I asked him to include a claim such as claim 44 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

454. Claim 44 is unlike any claim of the '947 patent as issued.

#### *Claim 45*

455. A new claim 45 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel select designations and retrieve corresponding tuning designations "following receipt of" an appropriate data set. Specifically, I did not claim my invention in a claim which

includes the limitations set forth in claim 9 of this application, and which further includes the limitations that:

said memory means further includes means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

said control output signal further comprises one of (c) a third data set representative of a desired channel select designation for one of said channel tuning designations, and (d) a fourth data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

said processor means further, following receipt of said third data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and following receipt of said fourth data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said processor signal to correspond to said one channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

456. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

457. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could claim my invention such that the processor means performed operations "following receipt of" certain other conditions, such as the presence of a particular data set, rather than "upon receipt of" such a data set. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "following receipt of" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

458. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 45 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

459. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

460. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

461. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

462. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

463. In September 1993, a reissue application for the '947 patent was filed.

464. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

465. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "following receipt of," which language would be broader than the language "upon receipt of."

466. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 45 in this application, which included the channel select designation, could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

467. Claim 45 is unlike any claim of the '947 patent as issued.

*Claim 46*

468. A new claim 46 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel select designations and retrieve corresponding tuning designations "following receipt of" an appropriate data set. Specifically, I did not claim my invention in a claim which includes the limitations set forth in claim 45 of this application, and which further includes the limitations that:

said memory means further includes means for storing at least one operator-assigned display designation for at least one of said channel tuning designations;

said control output signal further comprises one of (e) a fifth data set representative of a desired display designation for one of said channel tuning designations;

said processor means further, following receipt of said fifth data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and following receipt of said fourth data set, retrieving from said memory means the one of said display designations corresponding to said one channel tuning designation and causing said one display designation to be displayed on said display.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

469. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

470. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could claim my invention such that the processor means performed operations "following receipt of" certain other conditions, such as the presence of a particular data set, rather than "upon receipt of" such a data set. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that

the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "following receipt of" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

471. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 46 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

472. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

473. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

474. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947



patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

475. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

476. In September 1993, a reissue application for the '947 patent was filed.

477. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

478. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "following receipt of," which language would be broader than the language "upon receipt of."

479. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 46 in this application, which included the channel display designations, could have been

presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

480. Claim 46 is unlike any claim of the '947 patent as issued.

*Claim 47*

481. A new claim 47 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel select designations and retrieve corresponding tuning designations "following receipt of" an appropriate data set. Specifically, I did not claim my invention in a claim which includes the limitations set forth in claim 9 of this application, and which further includes the limitations that:

said memory means further includes means for storing at least one operator-assigned display designation for at least one of said channel tuning designations;

said control output signal further comprises one of (c) a third data set representative of a desired display designation for one of said channel tuning designations;

said processor means further, following receipt of said third data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and further following receipt of said second data set, retrieving from said memory means the one of said display designations corresponding to said next channel tuning designation and causing said one display designation to be displayed on said display.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

482. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

483. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could claim my invention such that the processor means performed operations "following receipt of" certain other conditions, such as the presence of a particular data set, rather than "upon receipt of" such a data set. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "following receipt of" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

484. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 47 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

485. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

486. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

487. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

488. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

489. In September 1993, a reissue application for the '947 patent was filed.

490. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

491. At approximately this same time (early 1994), Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski

and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "following receipt of," which language would be broader than the language "upon receipt of."

492. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 47 in this application, which included the channel display designations, could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

493. Claim 47 is unlike any claim of the '947 patent as issued.

#### *Claim 48*

494. A new claim 48 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver in which the apparatus included a television screen as one of the claim elements, and specifically did not do so in a claim which included the following other elements:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing at least one operator-assigned channel select designation for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means

the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said processor signal to correspond to said one channel tuning designation;

wherein said memory means includes means for storing a marker value for each of said channel select designations, and means for retaining said channel select designations in a plurality of ordered cues;

said control means including means for generating, at the selection of the operator, a part of said first data set representative of the presence of said marker value associated with one of said channel select designations and one of said cues, and means for generating a third data set representative of a command to advance to a subsequent channel select designation within a selected one of said cues;

said processor means, upon receipt of said first data set, causing said memory means to store any of said marker values associated with one of said channel select designations, and upon receipt of said third data set, reviewing the corresponding one of said cues to determine a next of said channel select designations to have one of said marker values associated therewith which corresponds to said cue, and generating said processor signal to correspond to said next channel select designation whereby a selected television channel is displayed on said screen.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

495. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

496. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that I could claim my invention including a television screen as one of the claim elements. It did not occur to me that such a claim might serve as a hedge in the event that other, broader claims might later be found to be invalid. I did not discuss whether the inclusion of "a television screen" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that

a claim in accord with claim 48 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

497. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented additional claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

498. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

499. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

500. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

501. In September 1993, a reissue application for the '947 patent was filed.

502. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action.

503. At approximately this same time (early 1994), I understand that Mr. Hokanson had suggested to Mr. Boshinski perhaps a claim could have been presented in the application for the '947 patent that included a television screen as one of the claim elements.

504. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 48 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

505. Claim 48 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 48 does not provide an operator-actuated control means in the form of separate, "first" and "second" means. Claim 48 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 48 include a processor means which includes a "means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...." Claim 48 includes the further limitation of a television screen.



*Claim 49*

506. A new claim 49 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes." I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned select code for at least one of said channel codes;

operator-actuated control means for generating a control output signal including a string of two or more label characters and comprising one of (a) a first data set representative at least in part of a desired select code for one of said channel codes, and (b) a second data set having as an initial character one of said label characters and representative of a desired viewing channel identified by an operator selected one of said select codes;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store said desired select code as corresponding to said one channel code, and in response to solely said second data set, retrieving from said memory means the one of said channel codes corresponding to said operator selected select code, and generating said channel tuning control signal to correspond to said one channel code.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

507. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

508. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

509. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

510. I also overlooked the fact that I could claim my invention such that the apparatus stored "select codes" as corresponding to one or more "channel codes." During the time the application was prepared and prosecuted, all claims used instead the language "channel select designation" and "channel tuning designation." It did not occur to me that "select code" and "channel code" could be used in the claims. I did not discuss whether this language could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

511. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 49 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

512. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

513. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

514. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

515. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

516. In September 1993, a reissue application for the '947 patent was filed.

517. In approximately early 1994, Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

518. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. Mr. Boshinski advised me that, based upon conversations he had had with Mr. Hokanson, it was his view that claims could have been presented in the application for the '947 patent in which the language "select code" and "channel code" instead of "select designation" and "tuning designation." He further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found invalid. He also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

519. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 49 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

520. Claim 49 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 49 does not include the tuner means of claim 1, nor does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1. In claim 49 the processor means operates "in response to" an input signal, rather than "upon receipt of" an input signal. Further, in claim 49, the device stores "select codes" as corresponding to "channel codes," rather than "channel select designations" for "channel tuning designations."

#### *Claim 50*

521. A new claim 50 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes." Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned select code for at least one of said channel codes;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired select code for one of said channel codes, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said select codes;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store said desired select code as corresponding to said one channel code, and in response to said second data set, retrieving from said memory means the one of said channel codes corresponding to said operator selected select code, and generating said channel tuning control signal to correspond to said one channel code;

said memory means including means for initially storing a select code for at least one of said channel codes which is identical thereto.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

522. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

523. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

524. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be

used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

525. I also overlooked the fact that I could claim my invention such that the apparatus stored "select codes" as corresponding to one or more "channel codes." During the time the application was prepared and prosecuted, all claims used instead the language "channel select designation" and "channel tuning designation." It did not occur to me that "select code" and "channel code" could be used in the claims. I did not discuss whether this language could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

526. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 50 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

527. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have

presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

528. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

529. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

530. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

531. In September 1993, a reissue application for the '947 patent was filed.

532. In approximately early 1994, Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then,



and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

533. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. Mr. Boshinski advised me that, based upon conversations he had had with Mr. Hokanson, it was his view that claims could have been presented in the application for the '947 patent in which the language "select code" and "channel code" instead of "select designation" and "tuning designation." He further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found invalid. He also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

534. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 50 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

535. Claim 50 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an operator-actuated control means and a processor means substantially as set out above. Claim 50 does not include the tuner means of claim 1, nor is the operator-actuated control means in the form of separate, "first" and "second" means. Claim 17 does not include a control output signal which comprises "a first one of said channels of said multi-channel input," nor does claim 50 include a processor means which includes a

"means for generating said processor signal to cause said tuner means to tune out all but said first one of said channels ...." In claim 50 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal. Further, in claim 50, the device stores "select codes" as corresponding to "channel codes," rather than "channel select designations" for "channel tuning designations."

*Claim 51*

536. A new claim 51 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes." Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned select code for at least one of said channel codes;

first operator-actuated control means for generating a first control output signal comprising a first data set representative of a desired select code for one of said channel codes;

second operator-actuated control means for generating a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said select codes;

processor means for receiving said first and second control output signals from said first and second operator-actuated control means, and in response to said first data set, causing said memory means to store said desired select code as corresponding to said one channel code, and in response to said second data set, retrieving from said memory means the one of said channel codes corresponding to said operator selected select code, and generating said channel tuning control signal to correspond to said one channel code.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

537. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

538. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

539. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

540. I also overlooked the fact that I could claim my invention such that the apparatus stored "select codes" as corresponding to one or more "channel codes." During the time the application was prepared and prosecuted, all claims used instead the language "channel select designation" and "channel tuning designation." It did not occur to me that "select code" and

"channel code" could be used in the claims. I did not discuss whether this language could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

541. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 51 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

542. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

543. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

544. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

545. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

546. In September 1993, a reissue application for the '947 patent was filed.

547. In approximately early 1994, Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

548. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. Mr.

Boshinski advised me that, based upon conversations he had had with Mr. Hokanson, it was his view that claims could have been presented in the application for the '947 patent in which the language "select code" and "channel code" instead of "select designation" and "tuning designation." He further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found invalid. He also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

549. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 51 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

550. Claim 51 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 51 does not include the tuner means of claim 1. However, it does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1. In claim 51 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal. Further, in claim 51 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal.

#### *Claim 52*

551. A new claim 52 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner

means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes." Specifically, I did not do so in a claim which included the following other elements:

memory means for storing at least one operator-assigned select code for at least one of said channel codes;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired select code for one of said channel codes, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said select codes;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store said desired select code as corresponding to said one channel code, and in response to said second data set, retrieving from said memory means the one of said channel codes corresponding to said operator selected select code, and generating said channel tuning control signal to correspond to said one channel code;

wherein said memory means includes means for storing more than one of said select codes corresponding to a single one of said channel codes.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

552. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

553. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a

television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

554. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

555. I also overlooked the fact that I could claim my invention such that the apparatus stored "select codes" as corresponding to one or more "channel codes." During the time the application was prepared and prosecuted, all claims used instead the language "channel select designation" and "channel tuning designation." It did not occur to me that "select code" and "channel code" could be used in the claims. I did not discuss whether this language could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

556. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 52 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

557. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller



of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

558. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

559. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

560. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

561. In September 1993, a reissue application for the '947 patent was filed.

562. In approximately early 1994, Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

563. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. Mr. Boshinski advised me that, based upon conversations he had had with Mr. Hokanson, it was his view that claims could have been presented in the application for the '947 patent in which the language "select code" and "channel code" instead of "select designation" and "tuning designation." He further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found invalid. He also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

564. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 52 in this application could have been presented in the original application for the '947

patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

565. Claim 52 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, an one operator-actuated control means and a processor means substantially as set out above. Claim 52 does not include the tuner means of claim 1. However, it does require that the memory means be capable of storing more than one channel select designation for at least one tuning designation, which is not found in claim 1. In claim 52 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal. Further, in claim 52 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal.

#### *Claim 53*

566. A new claim 53 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal, or wherein the "channel tuning designation" is defined as being "in a first series," and the "channel select designation" is defined as being "in a second series." Specifically, I did not do so in a claim which included the following other elements:

memory means for storing a plurality of said channel tuning designations within a first series, and for storing within a second series a plurality of operator-assigned channel select designations wherein each of said channel select designations within said second series corresponds to one of said channel tuning designations within said first series;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative at least in part of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and in response to said first data set, causing said memory means to store said desired channel select designation within said second series as corresponding to said one channel tuning designation within said first series, and in response to said second data set, retrieving from said first series the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said channel tuning control signal to correspond to said one channel tuning designation.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

567. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

568. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

569. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

570. I further overlooked the fact that I could claim my invention such that in the apparatus the "channel tuning designations" could be defined as being in a "first series," and the "channel select designations" could be defined as being in a "second series." I did not discuss whether this language could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

571. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 53 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

572. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

573. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

574. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

575. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

576. In September 1993, a reissue application for the '947 patent was filed.

577. In approximately early 1994, Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

578. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I

discussed the claims of the '947 patent as he prepared a response to the Office action. Mr. Boshinski advised me that Mr. Hokanson had expressed the view that the "channel tuning designations" could have been defined as being in a "first series" and the "channel select designations" could have been defined as being in a "second series," and that claims using this language would be helpful in explaining the manner in which my invention worked, how it differed from the prior art, and how the accused device was the same as my invention. Based on his conversations with Mr. Hokanson, Mr. Boshinski concluded that claims using this language could have been presented in the application for the '947 patent, and that such claims could serve as a hedge in the event that other, broader claims might later be found invalid.

579. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 53 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

580. Claim 53 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 53 does not include the tuner means of claim 1, nor does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1. In claim 53 the processor means operates "in response to" an input signal, rather than "upon receipt of" an input signal. Further, in claim 53, unlike claim 1, the device stores the "channel tuning designations" in a "first series" and the "channel select designations" in a "second series."

*Claim 54*

581. A new claim 54 is added in this application to correct the following error: I did not claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal, or wherein the "channel tuning designation" is defined as being "in a first series," the "channel select designation" is defined as being "in a second series," and the "channel display designation" is defined as being "in a third series." Specifically, I did not do so in a claim which included the limitations set forth in claim 53 of this application, and which included the following other elements:

said memory means further includes means for storing within a third series an operator-assigned display designation corresponding to at least one of said channel tuning designations within said first series;

said control output signal further comprises one of (c) a third data set representative of a desired display designation for one of said channel tuning designations;

said processor means further, following receipt of said third data set, causing said memory means to store said desired channel select designation within said third series as corresponding to said one channel tuning designation, and further following receipt of said second data set, retrieving from said third series the one of said display designations corresponding to said next channel tuning designation and causing said one display designation to be displayed on said display.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

582. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

583. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I overlooked the fact that it was not necessary



to include the tuner means of the television receiver as an element in claims to the control apparatus which I had invented. This was because I expected my device to be sold with a television which would include the television's own tuning means. I did not discuss whether the tuner means was a necessary claim limitation for my device with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

584. I also overlooked the fact that I could claim my invention such that the processor means performed operations "in response to" certain other conditions, such as the presence of a particular signal, rather than "upon receipt of" such a signal. This was because I erroneously concentrated on the preferred embodiment, in which the signal is received directly by the processor means, and the corresponding action of the processor means occurs immediately upon receipt of the signal (although I do not believe that the claim language "upon receipt of" is limited in this regard). I did not discuss whether the language "in response thereto" could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

585. I further overlooked the fact that I could claim my invention such that in the apparatus the "channel tuning designations" could be defined as being in a "first series," the "channel select designations" could be defined as being in a "second series," and a "channel display designation" could be defined as being "in a third series." I did not discuss whether this language could be used in claiming my invention with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent.

586. Both Mr. Boshinski and I inadvertently failed to appreciate that a claim in accord with claim 54 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

587. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented claims which did not include the tuning means as an element of the claims, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

588. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

589. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that the tuning means was not a necessary limitation of claims directed to my invention, although no such claims had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

590. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

591. In September 1993, a reissue application for the '947 patent was filed.

592. In approximately early 1994, Mr. Boshinski and I learned through Mr. Hokanson, who was representing me in the Gemstar litigation, that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Boshinski and Mr. Hokanson suggested that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

593. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. Mr. Boshinski advised me that Mr. Hokanson had expressed the view that the "channel tuning designations" could have been defined as being in a "first series," the "channel select designations" could be defined as being in a "second series," and "channel display designations" could be defined as being in a "third series." Claims using this language would be helpful in explaining the manner in which my invention worked, how it differed from the prior art, and how the accused device was the same as my invention. Based on his conversations with Mr.

Hokanson, Mr. Boshinski concluded that claims using this language could have been presented in the application for the '947 patent, and that such claims could serve as a hedge in the event that other, broader claims might later be found invalid.

594. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 54 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

595. Claim 54 is closest to claim 1 of the '947 patent, in that both claims have in common elements including the memory means, at least one operator-actuated control means and a processor means substantially as set out above. Claim 54 does not include the tuner means of claim 1, nor does require both first and second operator-actuated control means, one for generating the first data set and the other for generating the second data set, which is not found in claim 1. In claim 54 the processor means operates "in response to" in input signal, rather than "upon receipt of" an input signal. Further, in claim 54, unlike claim 1, the device stores the "channel tuning designations" in a "first series" and the "channel select designations" in a "second series," and includes "channel display designations" which are in a "third series."

#### *Claim 55*

596. A new claim 55 is added in this application to correct the following error: I did not claim in the '947 patent any method of controlling a television receiver, in particular one in which certain steps of the method are performed by a "first" and a "second" person. Specifically, I did not do so in a claim which included the limitations set forth in claim 5 of this application, and which included the following other element:

said step of generating said first control output signal is performed by a first person, and wherein said step of generating said second control output signal is performed by a second person.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

597. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

598. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I did not realize that my invention could be defined in terms of the method by which the television receiver was controlled. I incorrectly assumed that my invention was embodied in a device. More specifically, I did not realize that my invention could be claimed as a method in which certain steps of the method are performed by a "first" and a "second" person. I did not discuss the possibility of presenting a method claim with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a method claim in accord with claim 55 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

599. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was

suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented a method claim as a way of protecting my invention, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.

600. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

601. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that my invention could be defined in terms of a method claim, although no such claim had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

602. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

603. In September 1993, a reissue application for the '947 patent was filed.

604. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. Mr. Boshinski advised me that Mr. Hokanson, who was representing me in the Gemstar litigation, had expressed the view that method claims which clearly specified that certain steps in the method were carried out by a "first person" and a "second person" would be helpful in clarifying the manner in which some embodiments of my invention worked, how the accused device was

the same as my invention, and that such claims could serve as a hedge in the event that other, broader claims might later be found invalid. As a result of his conversations with Mr. Hokanson, Mr. Boshinski concluded that method claims using this language could have been presented in the application for the '947 patent.

605. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 55 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

606. Claim 55 is unlike any claim of the '947 patent.

*Claim 56*

607. A new claim 56 is added in this application to correct the following error: I did not claim in the '947 patent any method of controlling a television receiver, in particular one in which certain steps of the method are performed by a "first" and a "second" person. Specifically, I did not do so in a claim which included the limitations set forth in claim 5 of this application, and which included the following other element:

said step of generating said first control output signal is performed by a first person, and wherein said desired channel select designation is predetermined by a second person.

I did not present such a claim even though such a claim was within the scope of my invention as disclosed in the application for the '947 patent.

608. This error occurred during the time in which the application for the '947 patent was prepared and prosecuted, namely from about the summer of 1989 through September, 1991.

609. The error occurred in the following manner: During the time in which the application for the '947 patent was prepared and prosecuted, I did not realize that my invention could be defined in terms of the method by which the television receiver was controlled. I incorrectly assumed that my invention was embodied in a device. More specifically, I did not realize that my invention could be claimed as a method in which certain steps of the method are performed by a "first" and a "second" person. I did not discuss the possibility of presenting a method claim with Mr. Boshinski during the preparation or prosecution of the application for the '947 patent. Both Mr. Boshinski and I inadvertently failed to appreciate that a method claim in accord with claim 56 was within the scope of my invention, and that it should have been presented in the application for the '947 patent.

610. The error was discovered in the following manner: Prior to January 1993, I had been studying a situation wherein I believed Gemstar Development Corp., a manufacturer and seller of videorecorder control devices, was infringing my '734 patent. During the months of January through about March of 1993, Mr. Boshinski and I interviewed several attorneys about the possibility of representing me in connection with the Gemstar matter. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Boshinski and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning my case, their view of the merits of my case, and their possible representation of me. These discussions included a careful review of the scope of the claims of my '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that I could have presented a method claim as a way of protecting my invention, and he and Mr. Boshinski advised that I should consider the filing of an application to reissue one or the other of my patents.



611. As a result of these discussions, I realized that I had claimed less than I had a right to claim in the application for the '947 patent.

612. At about the same time, I was involved with the reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Boshinski and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Boshinski and I discussed during this time that my invention could be defined in terms of a method claim, although no such claim had been presented in the application for the '947 patent. This further convinced me I had claimed less than I had a right to claim in the '947 patent.

613. In August 1993, I brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with my '734 patent.

614. In September 1993, a reissue application for the '947 patent was filed.

615. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Boshinski and I discussed the claims of the '947 patent as he prepared a response to the Office action. Mr. Boshinski advised me that Mr. Hokanson, who was representing me in the Gemstar litigation, had expressed the view that method claims which clearly specified that certain steps in the method were carried out by a "first person" and a "second person" would be helpful in clarifying the manner in which some embodiments of my invention worked, how the accused device was the same as my invention, and that such claims could serve as a hedge in the event that other, broader claims might later be found invalid. As a result of his conversations with Mr. Hokanson, Mr. Boshinski concluded that method claims using this language could have been presented in the application for the '947 patent.

616. After discussing with Mr. Boshinski his realization that a claim like that presented as claim 56 in this application could have been presented in the original application for the '947 patent, but erroneously was not, I asked Mr. Boshinski to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

617. Claim 56 is unlike any claim of the '947 patent.

Errors in the Specification

618. I further believe the '947 patent to be partly invalid or inoperative by reason of a defective specification. The defects in the specification of the '947 patent, the associated errors and the manner in which such errors arose or occurred is specified for each change in the specification of the reissue application in the paragraphs below:

*Column 4, lines 25-26*

619. Column 4, lines 25-26 are amended in this application to correct the following error: The word "convention" should read --conventional--.

620. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

621. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

622. The error was discovered in the following manner: During the early part of 1994, Mr. Boshinski, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Boshinski and Mr. Hokanson together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 9, line 14*

623. Column 9, line 14 is amended in this application to correct the following error: The words "channel code" should read --select code--.

624. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

625. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

626. The error was discovered in the following manner: During the early part of 1994, Mr. Boshinski, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Boshinski and Mr. Hokanson together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was

prepared, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 9, line 53*

627. Column 9, line 53 is amended in this application to correct the following error: The word "the" (first occurrence) should read --then--.

628. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

629. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

630. The error was discovered in the following manner: During the early part of 1994, Mr. Boshinski, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Boshinski and Mr. Hokanson together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 10, lines 58*

631. Column 10, line 58 is amended in this application to correct the following error: The words "display code" should read --select code--.

632. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

633. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

634. The error was discovered in the following manner: During the early part of 1994, Mr. Boshinski, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Boshinski and Mr. Hokanson together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 11, lines 38-39*

635. Column 11, lines 38-39 are amended in this application to correct the following error: The words "display code" should read --select code--.

636. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

637. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

638. The error was discovered in the following manner: In September 1992, a request to have the '734 patent reexamined was filed with the U.S. Patent and Trademark Office, and as a result of that request and subsequent reexamination, a reexamination certificate for the '734 patent was issued on October 26, 1993. During that proceeding, Mr. Boshinski identified an identical error to that identified above in the '734 specification, and corrected such error. In reviewing the '947 patent in preparation of a response to the Office action dated February 18, 1994 in the present application, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 11, lines 39-40*

639. Column 11, lines 39-40 are amended in this application to correct the following error: The words "display code" should read --select code--.

640. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

641. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

642. The error was discovered in the following manner: In September 1992, a request to have the '734 patent reexamined was filed with the U.S. Patent and Trademark Office, and as a result of that request and subsequent reexamination, a reexamination certificate for the '734 patent was issued on October 26, 1993. During that proceeding, Mr. Boshinski identified an identical error to that identified above in the '734 specification, and corrected such error. In reviewing the '947 patent in preparation of a response to the Office action dated February 18, 1994 in the present application, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 12, line 19*

643. Column 12, line 19 is amended in this application to correct the following error: The words "display code" should read --select code--.

644. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

645. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically

copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

646. The error was discovered in the following manner: During the early part of 1994, Mr. Boshinski, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Boshinski and Mr. Hokanson together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 12, line 21*

647. Column 12, lines 21 is amended in this application to correct the following error: The number "208" should read --210--.

648. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

649. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.



650. The error was discovered in the following manner: In September 1992, a request to have the '734 patent reexamined was filed with the U.S. Patent and Trademark Office, and as a result of that request and subsequent reexamination, a reexamination certificate for the '734 patent was issued on October 26, 1993. During that proceeding, Mr. Boshinski identified an identical error to that identified above in the '734 specification, and corrected such error. In reviewing the '947 patent in preparation of a response to the Office action dated February 18, 1994 in the present application, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 12, line 28*

651. Column 12, line 28 is amended in this application to correct the following error: The words "display code" should read --select code--.

652. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

653. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

654. The error was discovered in the following manner: During the early part of 1994, Mr. Boshinski, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Boshinski and Mr. Hokanson together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734

specification. Because of the manner in which the specification for the '947 patent was prepared, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

*Column 12, lines 29-30*

655. Column 12, lines 29-30 are amended in this application to correct the following error: The words "display code" should read --select code--.

656. This error occurred during the time in which the application for the '947 patent was prepared, namely from about the summer of 1989 through April, 1990.

657. The error occurred in the following manner: I have been advised by Mr. Boshinski that he personally typed the specification for the application for the '947 patent. Mr. Boshinski had also personally typed the specification for my '734 patent. I further understand that because most of the specification is identical to that of the '734 patent, Mr. Boshinski electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. Mr. Boshinski had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

658. The error was discovered in the following manner: During the early part of 1994, Mr. Boshinski, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Boshinski and Mr. Hokanson together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, Mr. Boshinski realized that the same error was likely to be found in the '947 patent. He then reviewed the '947 patent, and found the above-described error.

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I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Jack Beery  
Jack Beery

3 November 1997  
Date